



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/263,098	03/05/99	RICKEY	M 00166.0063.U

022930
HOWREY & SIMON
1299 PENNSYLVANIA AVENUE NW
BOX 34
WASHINGTON DC 20004

HM12/0301

EXAMINER

AZPURU, C

ART UNIT	PAPER NUMBER
1615	5

DATE MAILED: 03/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/263,098

Applicant
Rickey et al

Examiner
Carlos Azpuru

Group Art Unit
1615



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-29 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-29 _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

Receipt is acknowledged of the preliminary amendments filed 03/05/99 and 12/16/99.

Information disclosure statements were filed on 03/05/99 and 12/20/99.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 5,792,477 ('477). Although the conflicting claims are not identical, they are not patentably distinct from each other because '477 claims a method of preparing a biodegradable, biocompatible microparticles which comprises preparing a first phase of a biodegradable polymer and an active agent, a second phase comprising polyvinyl alcohol, immersing both phases in a quench liquid, isolating said discontinuous first phase in the form of microparticles and washing. Those of ordinary skill would there fore expect

Art Unit:

similar results from the instantly claimed method given the claims '477. The instant claims would therefore have been obvious given the claims of '477.

3. Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,916,598 ('598). Although the conflicting claims are not identical, they are not patentably distinct from each other because '598 disclose a method of preparing a biodegradable, biocompatible microparticles which comprises preparing a first phase of a biodegradable polymer and an active agent, a second phase comprising polyvinyl alcohol, immersing both phases in a quench liquid, isolating said discontinuous first phase in the form of microparticles and washing. Those of ordinary skill would there fore expect similar results from the instantly claimed method given the claims '598. The instant claims would therefore have been obvious given the claims of '598.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Azpuru whose telephone number is (703) 308-0237. The examiner can normally be reached on Tuesday-Friday from 6:30 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone numbers for this Group are (703) 305-3592 and 305-4556. Unofficial faxes (such as proposed amendments to be used for an interview) may be sent to

Art Unit:

(703) 308-7924 or 7921. Unofficial faxes are intended for papers which will not become part of the official file, and it is requested the Examiner should be contacted in order to ensure prompt attention.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**thurman.page@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1234.

CARLOS A. AZPURU
PRIMARY EXAMINER
GROUP 1500

GROUP 1500
PRIMARY EXAMINER
CARLOS A. AZPURU

